

## **REMARKS**

Claims 1 through 7 and 9 through 15 remain pending in the present application. Claim 2 has been amended. Basis for the amendments can be found throughout the specification, drawings and claims as originally filed.

## **REJECTION UNDER 35 U.S.C. §102**

The Examiner has rejected Claims 2 through 5 under 35 U.S.C. §102(e) alleging them to be anticipated by DeLuca et al.

Claim 2 has been amended to eliminate the typographical errors. Accordingly, Claim 2 defines a gripping portion for a power tool which comprises a housing and a motor within the housing for actuating a power tool. The gripping portion is adapted to be engaged by the hand of the user. It further comprises at least one flexible sheet and at least one support having at least one aperture enabling a portion of the at least one flexible sheet to protrude through the at least one aperture. The flexible sheet is mounted to the support to retain gaseous vibration dampening medium between the support and a single thickness of the sheet.

The DeLuca et al. reference fails to disclose or suggest any type of power tool having a housing and a motor. Also, DeLuca et al. fails to disclose or suggest the flexible sheet on the housing of a power tool. Accordingly, Applicants believe DeLuca et al. does not anticipate Applicants' invention. Accordingly, Applicants respectfully request the Examiner to withdraw his 35 U.S. C. §102(e) rejection.

### REJECTION UNDER 35 U.S.C. §103(a)

The Examiner has rejected Claims 1, 6, 7 and 9 through 15 under 35 U.S.C. §103(a) alleging them to be unpatentable over Wadge (U.S. Patent No. 6,206,107) in view of DeLuca et al. (U.S. Patent No. 6,591,456). The Examiner alleges that this combination would render Applicants' invention obvious to those skilled in the art.

Independent Claim 1 defines, among other elements, a power tool which has a housing and a motor within the housing. A gripping portion with at least one flexible member and at least one clamping member having at least one aperture so that the at least one clamping member clamps the at least one flexible member to the housing. The member is clamped such that substantially none of the vibration dampening medium is located, in use, between the clamping member and the housing.

The Wadge reference cited by the Examiner fails to show any type of flexible member on the handle portion. In fact, upon reviewing the Wadge reference, Wadge mentions the handle of the device two times. The Wadge patent discloses and claims a power tool which includes a tool body which includes a removable head. A retention mechanism releasably secures the removable head to the tool body. Nowhere does the Wadge reference suggest the desirability of having any type of flexible member on its handle to cushion the gripping of the handle. In fact, only through the Examiner's hindsight, is the Wadge reference combined with DeLuca et al.

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests a desirability of the modification." In re Fritch 23 U.S.P.Q. 2d 1780 at 1783 (Fed. Cir. 1992). (Emphasis added.)

Here, the Wadge reference makes no mention of the desirability for any cushioning on the handle. In fact, Wadge only mentions the handle element twice. The

Examiner alleges that it would be combined with DeLuca et al. However, there is no motivation or suggestion in either of the two references to combine one with the other. Since Wadge discloses and claims a tool with a removable head and a retention member to retain the removable head, it is not concerned about its handle. Thus, there would be no desirability in Wadge to have a cushioned handle.

“The Examiner is relying upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. In re Fritch, supra, 1784.”

Here, only through the Examiner’s hindsight reconstruction, utilizing the Applicants’ invention as a template, can the Examiner obtain his conclusion. Wadge does not mention any type of cushioning device for a handle. The Examiner chooses a reference, DeLuca et al., which relates to writing utensils and alludes that it could be combined with a power tool. Only by using the Applicants’ invention as a template and picking and choosing isolated elements from these two references can the Examiner remotely allege obviousness of the present invention. Clearly, this is not the purpose of 35 U.S.C. §103. There must be some motivation or suggestion in the two references to combine them. Here, there is none. Accordingly, Applicants believe Claim 1 to be patentably distinct over the art cited by the Examiner.

Independent Claim 6 discloses and claims a power tool having a housing and a motor to actuate an output. Also, a chamber enclosing a gaseous vibration dampening medium extends outwardly from the gripping portion.

As mentioned above, the Wadge reference neither discloses or suggests the desirability of any type of dampening feature. Only through the Examiner’s hindsight

reconstruction can the Examiner allege this combination. Accordingly, Applicants believe Claim 6 and dependent Claim 7 to be patentably distinct over the art cited by the Examiner.

Independent Claim 9 defines a drill which has two chambers enclosing gaseous vibration dampening material, one chamber protruding from an opposite side of the drill handle. The chambers are discrete from one another. As mentioned above, the Examiner's hindsight combination, picking and choosing the isolated elements, fails to disclose or suggest Applicants' invention.

Independent Claim 12 discloses and claims a power sander. The sander includes a housing, a motor and a sanding plate. Also, a chamber encloses a gaseous vibration dampening medium. The chamber protrudes from an upper surface of the gripping portion.

The Examiner's combination fails to disclose or suggest a sander as claimed. Nowhere does the Wadge reference suggest the desirability of a cushioning member. The combination fails to disclose or suggest the sander as claimed.

Independent Claim 13 claims a power sander with a housing, a drive motor, and a sanding plate. Also, it includes a handle extending rearward from the main body. The chamber encloses a gaseous vibration dampening medium. As mentioned above, the Examiner's combination fails to disclose or suggest such a sander. Accordingly, Claim 13 as well as dependent Claim 14 overcome the Examiner's rejection.

Independent Claim 15 discloses a power saw. This saw includes a main body with a handle and a housing which receives a blade. A motor is disposed in the main housing. The handle includes a gripping portion. The chamber encloses a gaseous

vibration dampening medium which protrudes from the gripping portion. The Examiner's combination fails to disclose a power saw with a blade which includes a handle having a vibration dampening medium. As mentioned above, the Examiner's hindsight reconstruction fails to disclose or suggest Applicants' invention. Accordingly, Applicants believe independent Claim 15 to be patentably distinct over the art cited by the Examiner.

In light of the above amendments and remarks, Applicants submit that all pending claims are in condition for allowance. Accordingly, Applicants respectfully request the Examiner to pass the case to issue at his earliest possible convenience. Should the Examiner have any questions regarding the present application, he should not hesitate to contact the undersigned at (248) 641-1600.

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Respectfully submitted,

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